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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,571	11/12/2001	Denis Vincent	2-1034-061	8257

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STURM & FIX LLP  
206 SIXTH AVENUE  
SUITE 1213  
DES MOINES, IA 50309-4076

EXAMINER
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WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,571

Applicant(s)

VINCENT, DENIS

Examiner

Harry D Wilkins, III

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/460,471.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 5 and 6 are pending.
2. The obviousness-type double patenting rejection has been overcome by Applicant's filing of a terminal disclaimer. Therefore, the rejection is withdrawn.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 23 July 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,342,182 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimoto (JP 09-078160) in view of Kashiwagi (JP 09-184033) and Steinke et al (US 5,240,172).

These claims are rejected for the same reasons as stated in paragraph no. 6 of paper no. 7.

In response to the amended features of claim 1, Fujimoto teaches (see paragraph no. 17) that the alloy was produced by the usual gold-alloy method. Lost-wax casting was well known in the art to be the conventional method for the casting of

gold alloys (for support, see Kamohara et al at col. 1, lines 12-21). Therefore, it is implicitly disclosed that the alloy of Fujimoto was made by a lost-wax casting method.

***Response to Arguments***

6. Applicant's arguments filed 23 July 2003 have been fully considered but they are not persuasive. Applicant argued that:

- a. The additions of Ga and In were not suitable for lost-wax casting techniques;
- b. It was not obvious to discover the ranges of Pd and Cu which produce a gray alloy having color near that of rhodium; and
- c. The data submitted of the comparative tests show that the present invention achieves better appearance and color.

In response to Applicant's first argument, conclusory statements are not probative unless supported by facts. See *Ex parte Gray* 10 USPQ 2d 1922 (BPAI 1989); *In re deBlauwe* 222 USPQ 191, 196 (Fed. Cir. 1984); *In re D'Ancicco* 172 USPQ 241 (CCPA 1972); *In re Grunwell* 203 USPQ 1055 (CCPA 1979); *Meitzner v. Mindick* 193 USPQ 17; *In re Brandstandter* 179 USPQ 286, 294 (CCPA 1973); *In re Lindner* 173 USPQ 356; and, *In re Smith* 74 USPQ 207. Applicant's assertion that Ga and In were not suitable for lost-wax casting has not been supported by facts.

In response to Applicant's second argument, the Examiner disagrees. The Examiner feels it was no more than routine experimentation within the range of Fujimoto et al to discover the optimum working ranges of Pd and Cu.

In response to Applicant's third argument, the comparative data has not been considered because it was not filed in the form of a declaration or affidavit under 37 CFR 1.132. In addition, Applicant is trying to show the criticality of the presently claimed range, 12.5-13.5 wt% Pd, which finds no literal support in the specification as filed. Therefore, any attempt to assert unexpected results within the presently claimed range would be considered new matter.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-Th 10:00am-8:30pm.

Art Unit: 1742

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III  
Examiner  
Art Unit 1742

hdw

ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700